

## **REMARKS**

Claims 1-7, 9, and 11-20 are pending in the application. Claims 1, 4, 5, 12, and 13 have been amended hereby. Claim 3 has been cancelled, without prejudice or disclaimer. Claims 1, 4, 5, 12, and 13 are in independent form. Favorable reconsideration is requested.

Reconsideration is respectfully requested of the rejection of claims 1-6, 11-20 under 35 U.S.C. §103(a), as being obvious over U.S. Patent No. 5,835,087 (“*Herz*”) in view of U.S. Patent No. 5,946,664 (“*Ebisawa*”) and U.S. Patent Publication No. 2002/0068525 (“*Brown*”); and of the rejection of Claims 7 and 9, as being obvious over *Herz* in view of *Ebisawa*, *Brown*, and U.S. Patent No. 6,385,596 (“*Wiser*”).

It is respectfully submitted that the combination of *Herz*, *Ebisawa*, and *Brown* fails to show or suggest “selecting and retrieving advertising information by the advertising information server based on the digital contents identifier and the user identifier” as recited in amended Independent Claim 1, lines 6-7; in other words, the retrieval of the in-contents advertisements from the advertising information server based on the digital contents identifier and the user identifier, as shown in Fig. 2 and described in paragraphs [0009]-[0010]. *Herz*, as best understood, relates to a method of selecting future articles of interest to a user based on the frequency of certain text found in articles previously selected to be read by a user (see col. 78, lines 46-65) and including associated advertisements from a predetermined group based on a target profile. However, *Herz* fails to teach associating the advertisements directly with the user identifier; rather, content is linked solely to the content identifier (see col. 40, lines 9-12). This has the disadvantage that when an advertisement is “chosen randomly” from the set associated with the content identifier, the advertisement may not properly target the correct user profile.

*Ebisawa*, and *Brown* fail to cure the deficiency of *Herz*.

Regarding the Official Notice taken in the Office Action to assert that it is old and well known to create advertisements structure information containing at least portions and times regarding where advertisement insertion can be made in the digital contents, it is respectfully requested that Examiner provide specific references for the following reasons.

According to MPEP section 2144.03(A):

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

It is respectfully submitted that if, in fact, creating advertisements structure information containing at least portions and times regarding where advertisement insertion can be made in the digital contents is well known at all, it is not so well known as to be capable of instant and unquestionable demonstration as being well-known. Examiner states that "[i]t would be obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included creating advertisement information and providing said advertisement structure information to the advertisement information server; providing advertisement structure information containing at least portions and times regarding where advertisement insertion can be made in the digital contents to the advertisement information server; and creating and providing advertisement information created based on said advertisement structure information and specified information from the advertiser in order to obtain the above mentioned advantage." Implicit in Examiner's comment is the understanding that such an invention is not "capable of instant and unquestionable demonstration as being well-known;" rather, that this would merely be and obvious to someone skilled in the art.

Furthermore, MPEP section 2144.03(A) states:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21.

It is respectfully submitted that the retrieval of the in-contents advertisements from the advertising information server based on the digital contents identifier and the user identifier is clearly an example of esoteric technology, which would warrant a request for a citation of prior art references.

Finally, MPEP section 2144.03(E) states:

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.

In the Office Action, Official Notice has been taken as a principal evidence upon which rejection was based, and not simply to fill in the gaps. For this reason, it is respectfully requested that Examiner provide the applicant with documentary evidence in support of this rejection.

Accordingly, it is respectfully submitted that amended Independent Claims 1, 4, 5, 12 and 13, and the claims depending therefrom, are patentably distinct over the cited references, alone or in any possible combination.

In view of the amendments and remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,

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